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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,870	12/05/2005	Takamasa Iwaki	1083-9	6383

7590 07/18/2007
Jack Schwartz & Associates
Suite 1510
1350 Broadway
New York, NY 10018

EXAMINER

NGUYEN, SON T

ART UNIT	PAPER NUMBER
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3643

MAIL DATE	DELIVERY MODE
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07/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,870

Applicant(s)

IWAKI ET AL.

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SON T. NGUYEN
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-4,6-7,9-10,12** are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (5819688).

For claims 1-2,6, Walker teaches a small animal rearing cage 20,22 for housing and rearing small animals, said small animal rearing cage comprising: a rearing box having a floor 22 and a wall 20 provided at a circumference of said floor; a floor mat M laid in a small animals rearing cage for housing and rearing small animals, said floor mat is a sheet comprising a temperature holding property to a degree that can keep the body temperature of said small animals (the material used in Walker is the same material used in applicant, thus, the Walker material has temperature holding property; also, the mat of Walker can be an insulation to the animal laid thereon), a flexibility to a degree that can wrap the body of said small animals (col. 5, line 36, "pliable" and col. 6, lines 5-10, the mat can be folded, which is flexible to a degree to allow wrapping of the animal), and a size that covers at least the entire abdomen of said small animals (the mat covers the whole container 20, therefore, a small animal laying thereon will be covered by the mat from head to toes).

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For claims 3,9, Walker further teaches the sheet having water absorption property and deodorization property (col. 4, lines 45-55, col. 5, line 36).

For claims 4,10,12, Walker further teaches the sheet having tearing resistance (col. 5, lines 36, "strength").

For claim 7, Walker teaches that the mat is pliable and can be folded if one wishes to do so.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 5,8,11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (as above).

For claim 5, Walker teaches cellulose material formed into a shape of the sheet but is silent about an improved cellulose fabric wherein carboxyl group-introduced cellulose. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the cellulose material of Walker out of an improved cellulose fabric wherein carboxyl group-introduced cellulose, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. See Sinclair &

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Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945) and In re Leshin, 125 USPQ 416.

For claims 8,11, Walker states in col. 4, lines 30-34, that the mat can be any shape and size. However, Walker does not specifically state that the floor mat is a sheet larger in size than the floor area of said rearing box. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the mat of Walker with a dimension that is larger in size than the floor area of the rearing box in order to prevent urine or the like to reach the bottom of the rearing box. KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

Response to Arguments

5. Applicant's arguments filed 4/26/07 have been fully considered but they are not persuasive.

Applicant argued that Walker describes a flat mat (column 4, lines 37-38) with pliability, but does NOT describe a mat with flexibility to a degree that it can wrap the body of the small animals as in the present claimed invention.

Clearly, the mat of Walker can be folded (col. 6, lines 5-10) and it is pliable, thus, can perform the function of wrapping the body of the animal if one wishes to fold the mat to perform such function. Note the claim language of "can wrap", which is functional and intended use language (see MPEP section 2114) to which the apparatus of Walker can perform. Note also that in an apparatus claim, it is the structure of the element what counts and not how it is being used (again, see MPEP section 2114).

Applicant argued that the objective of Walker in providing pliability (for packaging and storing) is thus wholly unlike the objective of the present claimed invention in providing flexibility (for wrapping a small animal providing warmth and protection).

The intended use or objective of an apparatus is not a relevant limitation with respect to the patentability of the structure defined in an apparatus claim. In re Yanush, 477 F.2d 958, 959, 177 USPQ 705,706 (CCPA 1973).

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2114, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim. Although Walker's mat is "intended" to be pliable for packaging and storing, it, nevertheless, can be used for wrapping a small animal if one wishes to do so since the mat has capability to be folded.

Applicant argued that Walker describes that the mat may be essentially any size (column 4, line 29-34). It is therefore possible that the size of the mat described by Walker may be less than the entire abdomen of small animals. Walker neither discloses nor suggests the relationship of size of the mat to accommodate the abdomen of small animals as in the present claimed invention.

There is also a possibility that the size of the mat described by Walker may be MORE to cover the entire abdomen of small animals. Again, intended use recitation is not given patentable weight, especially when the device of the prior art is capable of performing the same intended function.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent

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Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Son T Nguyen
Primary Examiner
AU 3643